



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/804,478

03/13/2001

Makoto Suzuki

1614.1135

8768

21171

7590

01/13/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

JAMAL, ALEXANDER

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,478

Applicant(s)

SUZUKI, MAKOTO

Examiner

Alexander Jamal

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,15-19 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Examiner notes the amendment filed 11-18-2005 has been entered via RCE, examiner further notes that claims 1,6,18,19,21,27 have been amended and claim 28 has been added.
2. Examiner notes that two separate rejections based upon two different sets of prior art have been made for claims 27 and 28.

First set of rejections (all claims):

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1,3,4,18**, rejected under 35 U.S.C. 102(b) as being anticipated by Beatty et al. (5675630).

As per **claim 1**, Beatty discloses a mobile phone comprising a managing part (software in the phone) that manages functions and information in a manner linked to a plurality of using situations. The software will associate different speed dial directories with different using situations (NAMS) (ABSTRACT). The device further comprises a switch usable by the caller to set a specific using situation (Col 4 lines 25-35). The use of different NAMs allows the phone to be used in a business or personal situation (Col 2

Art Unit: 2643

lines 20-35). The device further comprises a control part (software) that will automatically select the appropriate function and information depending on the using situation, and make the information available to the user (abstract). Once a rule has been met (for example: by activating the switch), then the appropriate application and information are triggered and presented to the user (Col 4 lines 25-35). The purpose of the system is to associate and provide information (telephone number directories) to the user based upon the selected NAM (mode) of the phone. The information provided has a high probability of use by a user of a particular NAM mode since the information is associated to each appropriate NAM by the user

As per **claim 18**, Beatty discloses information terminal equipment that includes a computer using a computer readable medium that stores a program comprising a managing means (software) that manages functions and information in a manner linked to a plurality of using situations. The software will detect various parameters from the caller and manage the transfer of information to/from the caller as described in the rejections of claim 1.

As per **claim 3**, the NAM chosen (operating mode) can be applied to accounting (billing) destinations (Col 1 lines 15-35).

As per **claim 4**, the portable phone comprises a display and the appropriately selected phone directory/NAM information.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 6,19,27,28,15-16** rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty et al. (5675630), and further in view of Walsh (5642410).

As per **claim 6**, the claim is rejected for same reasons as the rejection of claim 1. Additionally, Beatty discloses a detector that detects several pieces of 'mode - information' (example: caller's location) to set a specific using situation (Col 2 line 64 to Col 3 line 10). The device further comprises a control part (software) that will automatically select the appropriate function and information depending on the using situation, and make the information available to the user (Col 4 lines 25-35). Once a rule has been met (for example: by activating the switch), then the appropriate application and information are triggered and presented to the user. Beatty discloses that the NAM modes may be activated by selection of any particular phonebook directory within the terminal. However, Beatty does not disclose that the NAM modes are triggered according to one of an email or telephone address belonging to a contacted party.

Walsh discloses a telecommunications terminal that automatically provides the appropriate information (using mode) to a user based upon the incoming or outgoing call information (Col 8 line 55 to Col 9 line 25). Walsh teaches that this computer-telephone integration system can save time (Col 1 lines 15-30). It would have been obvious to one of ordinary skill in the art at the time of this application that incoming or outgoing telephone numbers could be used as triggers to activate the various NAM modes of Beatty's system for the purpose of saving the user the time of having to manually activate the appropriate mode.

As per **claim 19**, claim rejected for same reasons as rejections of claims 6. Examiner notes that the 'mode information' recited in the claim may be the user selection (via incoming or outgoing telephone numbers for example) of the preferred NAM of Beatty's system.

As per **claims 27,28**, claim rejected for same reasons as claim 1. The phone user may enter in additions to the speed dial directory (via editing) (Col 6 lines 55-65). The phone will classify the phone directory entries that are executed as being associated with the NAM that is currently active (a first or second operating mode). The terminal is controlled to select the appropriate NAM (switch between operating modes) when the associated number is called or received.

As per **claims 15**, the NAM chosen (operating mode) can be applied to accounting (billing) destinations (Col 1 lines 15-35).

As per **claims 16**, the portable phone comprises a display and the appropriately selected phone directory/NAM information.

7. **Claim 5**, rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty et al. (5675630) as applied to claim 1 above, and further in view of Bijman (6047062).

As per **claim 5**, Beatty and Walsh discloses applicant's claims 1, but does not specify that the managing part automatically updates the data that depends upon the using situation and is not already included in the database.

Bijman teaches a method of automatically updating information stored in a database used in a telephone system (speed dialing system). He teaches the advantage of saving the user the trouble of manually updating the database (Col 1 lines 14-30) by having the phone system automatically add data (a new phone number) to the database. It would have been obvious to one of ordinary skill in the art at the time of this application to have the managing part automatically update the appropriate database for the advantage of saving the user the trouble of manually updating the database.

8. **Claim 17** rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty et al. (5675630) in view of Walsh (5642410) as applied to claim 6 above, and further in view of Bijman (6047062).

As per **claim 17**, Beatty and Walsh discloses applicant's claim 6, but do not specify that the managing part automatically updates the data that depends upon the using situation and is not already included in the database.

Bijman teaches a method of automatically updating information stored in a database used in a telephone system (speed dialing system). He teaches the advantage of saving the user the trouble of manually updating the database (Col 1 lines 14-30) by having the phone system automatically add data (a new phone number) to the database. It would have been obvious to one of ordinary skill in the art at the time of this application to have the managing part automatically update the appropriate database for the advantage of saving the user the trouble of manually updating the database.

9. **Claims 21-26** rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty et al. (5675630), and further in view of Shaffer et al (6477374).

As per **claims 21,25**, Beatty discloses claims 21,25 for the same reasons as the rejections of claims 1 and 6, but does not specify that the terminal equipment detects the using situation based upon time information.

Shaffer teaches a device (cellular phone) system that cross references a date and time (to reference a time the unit inherently comprises a timer) with a user's location so that a call may be routed or forwarded (ie. a different using situation is setup) based upon a user's location (Col 2 line 45 to Col 3 line 7). He teaches the advantage that a user may be more easily tracked down even if he/she forgot to leave a forwarding number (Col 2 lines 23-43), as well as the advantage of more efficient call routing (Col 1 lines 44-55). The activation of the NAM mode is based upon the appropriate location, which is based upon the time of day. It would have been obvious to one of ordinary skill in the art at the

Art Unit: 2643

time of this application to detect a user's time-location in order to set the using state (NAM selection) for the advantage of being able to more easily track down a user and being able to more efficiently route or handoff the call (the handoff is more efficient because the user may be able to use local access is the appropriate NAM is selected).

As per **claims 22,23**, Beatty's system displays the appropriate information based upon the selected mode (NAM).

As per **claim 24,26**, claim rejected for same reasons as claim 1.

Second set of rejections (claims 27 and 28)

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 27,28 rejected under 35 U.S.C. 102(b) as being anticipated by Walsh (5642410).

As per **claims 27 and 28**, Walsh discloses a telecommunications terminal that automatically provides the appropriate information (setting the appropriate mode) to a user based upon the incoming or outgoing call information (Col 8 line 55 to Col 9 line 25). The mode-associated information is classified in a mode because it has a high possibility of being used for that particular mode.

Art Unit: 2643

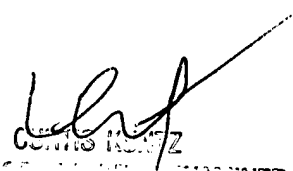
Response to Arguments

12. Applicant's arguments filed 11-18-2005 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 571-272-7498. The examiner can normally be reached on M-F 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 571-272-7499. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and **571-273-8300** for After Final communications.

AJ
January 9, 2006


CURTIS A. KUNTZ
SUPERVISOR, EXAMINER
JAN 10 2006